



PATENT  
3273-0153P

IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant:	Yasutaka ISHII et al.	Conf.:	1456
Appl. No.:	10/092,554	Group:	1626
Filed:	March 8, 2002	Examiner:	A. SMALL
For:	CATALYST COMPRISING A CYCLIC IMIDE COMPOUND AND PROCESS FOR PRODUCING ORGANIC COMPOUNDS USING THE CATALYST		

**RESPONSE TO REQUIREMENT FOR RESTRICTION**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

June 16, 2003

Sir:

In order to be fully responsive to the requirement for restriction that was mailed on May 16, 2003, Applicants elect the invention identified by the Examiner as Group I.

Applicants respectfully traverse the requirement for restriction between each of Groups I-III. Group IV, which should include claims 5-9, relates to a process invention. All of claims 1-4, however, relate to only one compound invention. Claim 3 is drawn to phthalimide compounds having oxycarbonyl (that is, ester) substituents. Claim 2 is a subgeneric claim that covers the phthalimide compounds of claim 3, as well as additional compounds. Claim 1 is a generic claim that covers the phthalimide compounds of claim 3 and all of the compounds covered by claim 2, as well as additional compounds.

Put another way, claim 2 depends from claim 1 and should be considered along with claim 1. As to claim 1, the compounds represented by Formula (I) are cyclic imides compounds having an N-substituted cyclic imide skeleton; they may have two substituents on the skeleton. These substituents may be alkyl, benzyl, or other groups singly bonded to the imide skeleton; alternatively, these substituents may be joined together to form a ring fused to the imide skeleton. The compound of Formula (I) having the substituents mentioned above includes the compounds represented by Formula (I) in claim 2, and Formula (I) clearly shows that the compound may have a ring formed by the combination of substituents  $R^1$  and  $R^2$ .

Even though claim 3 is an independent claim, it belongs in the same Group as claims 1 and 2. The compound represented by Formula (II) in claim 3 corresponds to the compound of Formula (I) having an aromatic ring formed by the combination of  $R^1$  and  $R^2$  with the imide skeleton. Claim 3 specifies a particular class of substituents ( $\text{COOR}^x$ ) on the fused aromatic ring. The claim 3 subject matter is also included in the in compounds of Formula (I) as that formula is defined in claim 1.

Accordingly, reconsideration and withdrawal of the requirement for restriction is respectfully solicited.

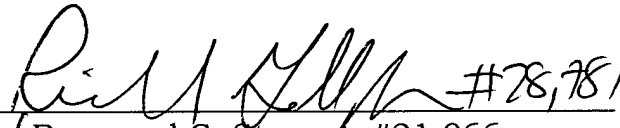
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Richard Gallagher (Reg. No. 28,781) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Application Number 10/092,554

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By  #78,781  
Raymond C. Stewart, #21,066

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COMPOUND AND PROCESS FOR PRODUCING  
ORGANIC COMPOUNDS USING THE CATALYST

LARGE ENTITY TRANSMITTAL FORM

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

June 16, 2003

Sir:

Transmitted herewith is a Reply to Restriction/Election Requirement in the above-identified application.

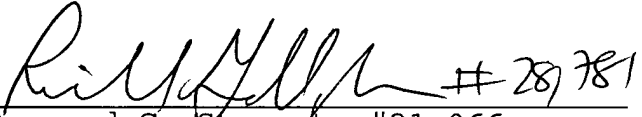
- ☐ The enclosed document is being transmitted via the Certificate of Mailing provisions of 37 C.F.R. § 1.8.
- ☐ Petition for \_\_\_\_\_ ( ) month(s) extension of time pursuant to 37 C.F.R. §§ 1.17 and 1.136(a). \$0.00 for the extension of time.
- ☒ No fee is required.
- ☐ A check in the amount of \$0.00 is enclosed.
- ☐ Please charge Deposit Account No. 02-2448 in the amount of \$0.00. A triplicate copy of this sheet is attached.

Appl. No. 10/092,554

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

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Attachment(s)

(Rev. 04/30/03)